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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,745	07/23/2001	Daniel P. Lyon	135122-C2	8064
24587	7590	12/21/2004	EXAMINER	
ALCATEL USA INTELLECTUAL PROPERTY DEPARTMENT 3400 W. PLANO PARKWAY, MS LEGL2 PLANO, TX 75075				PATEL, JAY P
		ART UNIT		PAPER NUMBER
		2666		

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/911,745	LYON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jay P. Patel	2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 7/23/2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 23 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5850387 in view of Steierman (U.S. Patent 4545052).

3. Claims 1 and 13 of the instant application merely broadens the scope of the claims 1 and 13 of the Patent by eliminating the elements and their functions of the claims. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPS). Also note *Ex parte Rainu*, 168 USPQ 375 (Bs. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

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4. Regarding claims 1 and 13 of the instant application, claim 1 of U.S. Patent No. 5850387 discloses A method of terminating and creating a synchronous transport signal, comprising steps of: receiving an inbound synchronous transport signal; extracting an inbound synchronous payload envelope of the inbound synchronous transport signal; mapping embedded signals within the inbound synchronous payload envelope into an inbound matrix payload envelope format; generating an inbound matrix transport format from the inbound matrix payload envelope format, the inbound matrix transport format carrying embedded signals for cross-connection to appropriate destinations; and mapping the inbound synchronous payload envelope into an inbound synchronous transfer mode signal; extracting plesiochronous digital hierarchy signals from the inbound synchronous transfer mode signal; placing the plesiochronous digital hierarchy signals into plurality of channels having a matrix payload envelope signal format; multiplexing the plurality of channels; converting the multiplexed plurality channels into matrix transport signals; serially transmitting the matrix transport signals.

5. The instant application fails to disclose the limitations of the inbound matrix payload envelope format having a byte interleaved structure and an inbound matrix format having a bit interleaved structure, generating an inbound matrix transport format having a bit interleaved structure, multiplexing the plurality of channels into byte interleaved parallel form and converting the multiplexed byte interleaved parallel form into bit interleaved matrix transport signals and serially

terminating the bit interleaved matrix transport signals. Claim 1 and 13 of U.S. Patent No. 5850387 discloses the above-mentioned underlined limitations.

6. It is noted that the instant application in view above, merely broadens the scope of the claims 1 and 13 of the Patent by eliminating the elements and their functions of the claims. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPS). Also note *Ex parte Rainu*, 168 USPQ 375 (Bs. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

7. In regards to claims 2-12 and 14-18, they are directed to the same subject matter as described in claims 2-12 and 14-18 of U.S. Patent No. 5850387, respectively.

8. In regards to claims 19 and 20, they are directed to the same subject matter as described in claims 5 and 6 of U.S. Patent No. 5850387, respectively.

### ***Conclusion***

9. References considered pertinent to the art but not used in this office action as a basis for rejection are as follows:

- a. U.S. Patent 5267239: Cross-Connect method for STM-1 signals of the synchronous digital multiplex hierarchy: Pospischil et al.
- b. U.S. Patent 5040170: System for cross-connecting high speed digital signals: Upp et al.

c. U.S. Patent 4185269: Error correcting system for serial by byte data:  
Hodges et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay P. Patel whose telephone number is (571) 272-3086. The examiner can normally be reached on M-F 9:00 am - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2666



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PRIMARY EXAMINER